

**d.) Remarks**

In the instant Office Action the sole reference relied upon in rejecting claims is the MacGregor '958 patent. This reference issued June 10, 2003 from a US application filed August 11, 2000 that claims priority based on four provisional applications, all filed on August 12, 1999. Thus the earliest possible effective filing date of the MacGregor reference is August 12, 1999.

Applicants submit herewith a Declaration under 37 CFR 1.131 to swear behind the MacGregor reference, based on the facts that applicants conceived and reduced to practice the invention long prior to the effective filing date of the MacGregor patent. As stated in the Declaration, applicants conceived of the invention in or about April, 1996 and reduced the invention to practice in or about July, 1997, and submitted a report containing these dates to the Office of Technology Licensing of the University of California at Berkeley in 1997.

Furthermore, a working prototype of the invention was demonstrated by Mark Gummin to a colleague in 1998, long prior to the effective filing date of the reference.

As supporting evidence applicants have attached to the Declaration the following documentation:

Exhibit A, which is an excerpt from their report of the invention to the Office of Technology Licensing of the University of California at Berkeley in 1997;

Exhibit B, which is a Declaration from Gerald Murphy describing that on a date certain in 1998 he witnessed a working prototype of the invention;

Exhibit C, which is a copy of a letter from the Office of Technology Licensing of the University of California at Berkeley in which applicants are granted the return of the entire right, title, and interest in an to this invention.

It is clear that that Exhibit A sets forth, at the very least, the conception of the invention, with drawings dated 2/10/97, that detail the use of shape memory wires connected between sliding links to translate the links and achieve additive motion of the links in a linear actuator arrangement. Exhibit A sets forth a date of reduction to practice, but there is no overt corroboration.


Exhibit B provides clear and convincing corroboration of reduction to practice of the invention in 1998, through the first person account of a technically trained individual who observed, witnessed, and understood the device and its operation.

Exhibit C sets forth the fact that the Office of Technology Licensing of the University of California at Berkeley recognized the creation and development of the present invention by applicants, and granted applicants the rights to patent and exploit the invention for their own benefit.

The Declaration of applicants, together with the Exhibits, are more than sufficient to meet the requirements of MPEP 715.07, and applicants assert that the rejection over the MacGregor reference should be withdrawn. It is noted for the record that the reference does not claim the same invention as the present claims, so that there is no potential for raising a question of interference between the reference and this application.

Due to the fact that the only rejection of the claims is based on the MacGregor patent, and that rejection is properly withdrawn in response to the showing under 37 CFR 1.131, there is no remaining impediment to issuance of all claims now presented in this application. Action toward that end is earnestly solicited.

Respectfully Submitted,

A handwritten signature in cursive script, reading "Howard Cohen", is written over a horizontal line.

Howard Cohen  
Registration No. 27,118  
1105 The Alameda  
Berkeley, CA 94707  
510-524-7733  
fax 510-558-7260